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500.32032CC6

4-2-99

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: K. MATSUBARA, et al.
Serial No.: 09/132,085
Filed: August 10, 1998
For: DATA PROCESSING APPARATUS HAVING A
FLASH MEMORY BUILT-IN WHICH IS
REWRITABLE BY USE OF EXTERNAL DEVICE
Group: 2818
Examiner: V. Le

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TECHNOLOGY CENTER 2800

RESPONSE INCLUDING SUBMISSION OF TERMINAL DISCLAIMER

Assistant Commissioner for
Patents
Washington, D.C. 20231

March 29, 1999

Sir:

In response to the outstanding Office Action, dated November 30, 1998, the period for response for which extension is requested in the accompanying Petition for Extension of Time, the following responsive remarks along with an accompanying and properly executed Terminal Disclaimer and appropriate fee amount, pursuant to 37 CFR §1.20(d), are respectfully submitted in connection with the above-identified application. (The fee amount covering this Terminal Disclaimer is included in the check attached to the Petition for Extension of Time.)

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According to the outstanding Office Action, claims 1 - 8, 15, 16, 18 - 24, 30 - 36, 38, 41 stand rejected "under the judicially created doctrine of obviousness-type double

patenting" over claims 1 -9 of U.S. Patent No. 5,687,345; claims 10 and 12 stand rejected "under the judicially created doctrine of obviousness-type double patenting" over the disclosure of claim 1 of U.S. Patent No. 5,581,503; and claim 11 is similarly rejected "under the judicially created doctrine of obviousness-type double patenting" over the claimed disclosure of claims 1, 2 and 4 of U.S. Patent No. 5,768,194. As for these three rejections, which cover all of the presently pending claims, Applicants are submitting herewith a properly executed Terminal Disclaimer. The submission of this Terminal Disclaimer, should not be construed as an acquiescence of the merits of any one or more of these claims, but, rather, is being presented, at this time, as a practicality insofar as removing these outstanding issues in the hope of rendering the instant application in condition for early allowability. That is, since no other issues remain outstanding, Applicants have decided, at the present time, to submit this Terminal Disclaimer in the hope of avoiding any unnecessary delays with regard to rendering the present application in condition of formal allowability. The filing of the accompanying Terminal Disclaimer as well as executing of the same by an attorney of record (of the below-named law firm) are consistent with the rules as well as with the USPTO guidelines concerning the manner for obviating rejections on such "non-statutory" double patenting grounds.

Applicants, through the undersigned representative,

submit the accompanying Terminal Disclaimer is in proper form, consistent with the applicable requirements pursuant to 37 CFR §1.321(b) and (c). Specifically, the accompanying Terminal Disclaimer, it is submitted, was properly executed by an authorized attorney of record, pursuant to 37 CFR §1.321(b)(1)(iv). Also, this Terminal Disclaimer properly states that the "petitioners, Hitachi Ltd, and Hitachi ULSI Engineering Corp., ... are jointly the owners of the entire interest of U.S. application Serial No. 09/132,088, ... and that the "[petitioners] ... hereby disclaim the terminal part of the statutory term of any patent granted on the instant application which would extend beyond March 16, 2013, which is the expiration date of the full statutory term, defined in 35 USC §154 to 156 and 173, of [prior] U.S. Patent No. 5,581,503, ... and of U.S. Patent No. 5,687,345, ... but is before the expiration date of prior U.S. Patent No. 5,768,194, ... and ... hereby agrees that any patent so granted on the above-identified application shall be enforceable only for and during such period so that it and the prior U.S. Patent Nos. 5,581,503, 5,687,345 and 5,768,194 are commonly owned. (Emphasis added).

Moreover, the accompanying Terminal Disclaimer further states: "[t]his disclaimer is to be binding with respect to any patent granted on the above-identified application, and is binding upon grantees, their successors, or assignees of any interests," consistent with the requirements pursuant thereto.

It is also properly stated, in the Terminal Disclaimer, the "petitioners" (owners) ... do not disclaim the terminal part of any patent on the instant application prior to the expiration date of the full statutory term, defined in 35 USC §154 to 156 and 173, ... in the event that any of prior U.S. Patent Nos. 5,581,503, 5,687,345 and 5,768,194: expires (expire) for failure to pay a maintenance fee; is (are) held unforceable; is (are) found invalid, is (are) statutorily disclaimed in whole or terminally disclaimed under 37 CFR §1.321; has (have) all claims cancelled by a reexamination certificate; is (are) reissued, or is (are) otherwise terminated prior to the expiration of the above-referred-to full statutory term, except for the separation of legal title ... , " consistent with the guidelines for Terminal Disclaimers. (Emphasis added)

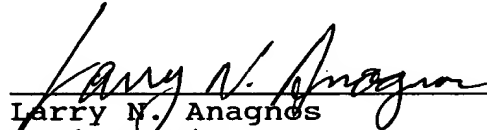
Therefore, in view of the accompanying properly executed Terminal Disclaimer and the appropriate fee amount together with these remarks, favorable action therefore together with an early formal notification of allowability of the above-identified application is respectfully requested.

To the extent necessary, applicants petition for an extension of time under 37 C.F.R. §1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to

Deposit Account No. 01-2135 (Case No. 500.32032CC6) and
please credit any excess fees to such Deposit Account.

Respectfully submitted,

ANTONELLI, TERRY, STOUT & KRAUS, LLP

A handwritten signature in cursive script, appearing to read "Larry N. Anagnos", is written over a horizontal line.

Larry N. Anagnos
Registration No. 32,392

LNA:dg
Attachment
(703/312-6600)